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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/399,192	09/17/1999	JOHN WANKMUELLER	AP31994-0704	1972

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EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT	PAPER NUMBER
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3685

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09/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/399,192	Applicant(s) WANKMUELLER ET AL.	
	Examiner CHARLES C. AGWUMEZIE	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 17-29, 33-45, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-29, 33-45, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1-13, 17-29, 33-45, 49 and 50 have been examined.

Response to Arguments

2. Applicant's arguments filed May 12, 2008 have been fully considered but they are not persuasive.

3. With respect to **claims 20, 21, and 33-34**, Applicant argues that the alleged method steps are features of the claimed system. Specifically, the rejected claims all recite systems that comprise among other things, the alleged method steps.

In response, Examiner respectfully disagree with Applicant's interpretation and submit that an apparatus claim that recites both an apparatus and a method for using said apparatus is indefinite under section 35 U.S.C § 112, 2nd paragraph as shown in the rejection.

4. With respect to **claim 1**, Applicant argues that the recited claim limitation "providing an ATM PIN related to a first transaction type that is an ATM transaction" and "generating a non ATM electronic commerce PIN ... to be entered by a user ... in a non ATM financial transaction" is not disclosed or suggested by Walker or Everett whether considered individually or in combination.

In response, Examiner respectfully disagrees and submits that there is no transaction being taking place in claim 1. The steps of providing, generating and transmitting does not involve transaction as applicant appears to argue. The word

"related" is a very broad term. A credit card or PIN relates to a transaction type (ATM transaction) when the card or PIN is used to obtain money or cash through the ATM. The same card can be used in non ATM related transaction (internet purchase) when the card or PIN is used to purchase an item via the internet.

5. Applicant further argues that there is no motivation to combine the references

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore the Examiner notes that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396.

6. Applicant further argues with respect to claim 1 that Examiner has not stated that Walker discloses the claimed features of "generating a non ATM electronic commerce PIN on a central computer by performing a cryptographic operation on said ATM PIN, said non ATM electronic PIN to be entered by a user in a second transaction type that is a non ATM financial transaction; and transmitting said non ATM electronic commerce PIN to said user" as recited in claim 1. That generating a second numerical code on a

central computer by performing a cryptographic operation on the first numerical code and cryptographically computed data is not the same as applicant claimed features.

In response and as discussed above, the word "related" is a very broad term. Credit card number and PIN relates to an ATM transaction when used to obtain cash. The same credit card can be used to transact on line to purchase goods and services with the credit card or PIN relating to the online non ATM transaction. Furthermore there is no transaction taking place in the applicant's claimed invention since the claimed steps of providing, generating and transmitting does not involve any transaction.

7. As per claims 2-13, 18-29, 34-45 and 50, Applicant argues that these claims are allowable being dependent directly or indirectly from independent claims 1, 17, 33 and 49.

In response, Examiner disagrees and submits that dependent claims 2-13, 18-29, 34-45 and 50 are not patentable either because of their dependency from their respective independent claims or for their own merits.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 20, 21 and 33-45** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 is directed to an apparatus. However, the claim also recites method steps (e.g. "... cause the processor to perform the steps of..."). It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2 (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)). Therefore, claim 33 is rejected at least as it does not sufficiently provide an accurate determination of the 'metes and bounds' of the Applicant's apparatus (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)). Claims 20, 25 (i.e. wherein the cryptographic operation uses...) and 34-45 are also rejected as each recites language similar to claim 33.

Claims 21 and 34-45 are also rejected as each depends from either claim 29 or 33.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-13, 17-29, 33-45, 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., U.S. Patent No. 6,163,771 in view of Everett et al., U.S. Patent No. 6,575,372.

12. As per claims 1-13, 17-29, 33-45, 49 and 50, Walker et al. teach a method for generating identification data comprising:

- providing a first numerical code (i.e. credit card number/account number) (figure 5, item 501, figure 13; column 7, lines 45-48 and lines 60-61; column 8, lines 20-25; column 11, lines 25-40)
- generating a second numerical code on a central computer by performing a cryptographic operation (e.g. addition or subtraction) (column 8, lines 19-25) on the first numerical code (figure 13; column 11, lines 25-40) and cryptographically computed data (column 7, lines 62-64; column 8, lines 13-17; column 11, lines 25-40)
- providing a conversion key and using the conversion key to perform the cryptographic operation on the first code (column 8, lines 16-25)
- deriving the conversion key by cryptographically (e.g. DES) (column 9, lines 10-20; column 10, lines 5-10) applying a (secret) deriving key to conversion key (initial) data (column 7, lines 62-64; column 8, lines 13-17; column 11, lines 25-40)

- generating cryptographically computed data (column 7, lines 62-64; column 8, lines 13-17; column 11, lines 25-40) wherein the data has the same base (e.g. 2 or 10) as the first numerical code (figure 5, item 501)

Walker et al. do not specifically apply their method to the generation of PINs. However, a PIN is merely a numerical code and Walker et al. teach that their numerical codes can be of arbitrary length (e.g. a-bit account number-column 7, lines 60-61 and column 11, lines 25-40). Also, it is well known that a PIN can be of any given length. In addition, in the context of Applicant's claim a PIN is merely intended use and Walker et al. do disclose entering both the first and second numbers for engaging in a financial transaction (column/line 1/5-2/62; column 11, lines 45-62). Therefore, it would have been obvious to one of ordinary skill to apply the method of Walker et al. generating numbers that can be used as a PIN. Walker et al. also [inherently] teach manually providing a user with a card wherein the card is pre-stored with a second numerical code (column 11, lines 25-40). It has been held that invention is not the replacing of a manual activity with a mechanical or automatic means which accomplishes the same result (*In re Venner*, 120 USPQ 192 (CCPA 1958); *In re Rundell*, 9 USPQ 220 (CCPA 1931); *Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 82 USPQ2d 1687 (Fed. Cir. 2007)), hence, it would have been obvious to one of ordinary skill to automate the process of providing second codes by transmitting the codes to a device such as

a smart card (figure 1; column 5, lines 49-61) over a network. On the other hand, Everett et al. teach transmitting card data (column 8, lines 40-67) such as card numbers (column 2, lines 46-54) to a smart card (column 3, lines 42-55) over a network (column 8, lines 40-67). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Walker et al. and Everett et al. in order to allow a credit card issuer to update card data without having to go through the expense of providing a new card to a user ('372, column 3, lines 53-67).

13. As per claims 5 and 9-11, Applicant attempts to limit the claimed method by further describing the derivation data. However, it has been held that data stored in computer memory that is not functionally related to the memory will not differentiate a claimed method from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II). Hence, the composition of the claimed derivation data cannot be relied upon to distinguish the claimed from the teachings of Walker et al. (column 7, lines 62-64; column 8, lines 13-17).

14. As per claims 20-21, and 33-45, it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Therefore, how Applicant's apparatus is intended to perform will not differentiate the claims from the prior art.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Zingher et al. disclose PINs of N digits

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the

responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Charles C.L. Agwumezie** whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Calvin Hewitt** can be reached on **(571) 272 – 6709**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/
Examiner, Art Unit 3685
August 27, 2008

/Calvin L Hewitt II/

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